No. 85-1243 (3)

Supreme Court, U.S.
FILED
FEB 21 1986
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

Supreme Court of the United States

October Term, 1985

NICK N. NOVICKY,

Petitioner,

vs.

SYNTEX OPHTHALMICS, INC. and ARAPAHOE CHEMICALS, INC. (now SYNTEX CHEMICALS, INC.),

Respondents.

NICK N. NOVICKY,

Petitioner,

vs.

GEORGE F. TSUETAKI and FUSED KONTACTS OF CHICAGO, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

BRIEF OF RESPONDENTS IN OPPOSITION

JAMES W. GOULD
MORGAN, FINNEGAN, PINE, FOLEY & LEE
345 Park Avenue
New York, New York 10154
(212) 758-4800
Counsel of Record for Respondents Syntex

Of Counsel:

JOSEPH A. DEGIROLAMO
MORGAN, FINNEGAN, PINE, FOLEY & LEE

---

23 pp

Counter Statement of Questions Presented for Review

1. On remand, did the Court of Appeals for the Federal Circuit properly consider *Marrese* v. *American Academy of Orthopaedic Surgeons*, 470 U.S. ——, 105 S.Ct. 1327, 84 L.Ed. 2d 274 (1985), in reaffirming its prior decision?

2. Was the extraordinary writ of mandamus properly denied when mooted by issuance and reaffirmance of the mandate of the Court of Appeals for the Federal Circuit to the District Court?

Parties to the Proceeding

The parties named in the caption are the only parties to this action. Respondents' statement pursuant to Rule 28.1 is set forth in the margin.*

* Syntex Ophthalmics, Inc. and Arapahoe Chemicals, Inc. (now Syntex Chemicals, Inc.) are Delaware corporations. They were formerly sister corporations, each being a wholly owned subsidiary, directly or indirectly, of Syntex (U.S.A.) Inc. which is a Delaware corporation with its principal place of business in California. As of December 19, 1985, all stock of Syntex Ophthalmics, Inc. was purchased by Pilkington Brothers, p.l.c., a corporation of the United Kingdom. Syntex Ophthalmics, Inc. has its principal place of business in Arizona. Syntex Chemicals, Inc. has its principal place of business in Colorado.

Petitioner Nick N. Novicky, an individual, is affiliated with Progressive Chemical Research Inc. in Whitby, Ontario, Canada, and has a laboratory in Calgary, Canada at 4315 64th Avenue.

George F. Tsuetaki is a resident of the state of Illinois with a business address at Five North Wabash Avenue, Chicago, Illinois.

Fuse[illegible] Kontacts of Chicago, Inc. is an Illinois corporation wholly owned by George Tsuetaki with its principal place of business in Chicago, Illinois.

TABLE OF CONTENTS

	PAGE
COUNTER STATEMENT OF QUESTIONS PRESENTED FOR REVIEW	1
PARTIES TO THE PROCEEDING	II
OPINIONS BELOW	2
A. The Federal Case	2
B. The State Case	3
JURISDICTIONAL STATEMENT	3
SUMMARY OF ARGUMENT	3
COUNTER STATEMENT OF THE CASE	4
ARGUMENT	5
A. Summary Judgment Of Syntex' Title To The Non-Private Patents And Applications Was Properly Reaffirmed	6
B. The Recorded Assignments Perfect Syntex' Title To The Patents In Issue	9
C. Denial Of Mandamus Was Proper Because The District Court Was Acting Under A Mandate	12
D. Novicky's Remaining Arguments Are Barred By Law Of The Case, Are Beyond The Narrow Remand, Or Are Premature	13
CONCLUSION	16

TABLE OF AUTHORITIES

PAGE

Cases:

Bradley v. Howard Hembrough Volkswagen, Inc., 89 Ill. App. 3d 121, 411 N.E.2d 535 (4th Dist. 1980) ... 7
Bushman Construction Co. v. Conner, 307 F.2d 888 (10th Cir. 1962) ... 9

Crown Die & Tool Co. v. Nye Tool & Machine Works, 261 U.S. 24, 43 S.Ct. 254, 67 L.Ed. 516 (1923) ... 11

Dunigan v. United States, 274 U.S. 195, 47 S.Ct. 566, 71 L.Ed. 566 (1927) ... 16

Ellis v. Dixon, 349 U.S. 458, 75 S.Ct. 850, 99 L.Ed. 1231 (1955) ... 16

Gayler v. Wilder, 51 U.S. 477, 13 L.Ed. 504 (1850) ... 11
Goodman v. Mead Johnson & Co., 534 F.2d 566 (3rd Cir. 1976), *cert. denied*, 429 U.S. 1038 (1977) ... 9

Heywood-Wakefield Co. v. Small, 96 F.2d 496 (1st Cir. 1938), *cert. denied*, 305 U.S. 663 (1938) ... 12

Marrese v. American Academy of Orthopaedic Surgeons, 470 U.S. ——, 105 S.Ct. 1327, 84 L.Ed. 2d 274 (1985) ... 3, 4, 5, 6
Mull v. Ford Motor Co., 368 F.2d 713 (2d Cir. 1966) ... 10
Myers v. Manchester Insurance & Indemnity Co., 572 F.2d 134 (5th Cir. 1978) ... 10

Novicky v. Syntex Ophthalmics, —— U.S. ——, 105 S.Ct. 1740, 84 L.Ed. 2d 807 (1985) ... 3

Pittsburgh, Cincinnati, Chicago & St. Louis Railway Co. v. Gage, 286 Ill. 213, 121 N.E. 582 (1918) ... 7
PSL Realty Co. v. Granite Inv. Co., 86 Ill. 2d 291, 427 N.E.2d 563 (1981) ... 7

PAGE

Scaife v. Western North Carolina Land Co., 90 F. 238 (4th Cir. 1898), *cert denied*, 173 U.S. 705 (1899) 11
Shlensky v. South Parkway Building Corp., 44 Ill. App. 2d 135, 194 N.E.2d 35 (1st Dist. 1963) 7, 8
Spiller v. Continental Tube Co., 95 Ill. 2d 423, 447 N.E.2d 834 (1983) 6
Syntex Ophthalmics, Inc. v. Novicky, 214 U.S.P.Q. 272 (N.D. Ill. 1982), *aff'd sub nom.*, Syntex Ophthalmics, Inc. v. Tsuetaki, 701 F.2d 677 (7th Cir. 1983) 2, 13
Syntex Ophthalmics, Inc. v. Novicky, 591 F. Supp. 28 (N.D. Ill. 1983), *aff'd in part, rev'd in part*, 745 F.2d 1423 (Fed. Cir. 1984) 2, 13, 14
Syntex Ophthalmics, Inc v. Novicky, 745 F.2d 1423 (Fed. Cir. 1984), *vacated* 105 S.Ct. 1740 (1985) 2, 8, 13, 14, 15
Syntex Ophthalmics, Inc. v. Novicky, 767 F.2d 901 (Fed Cir. 1985) 3, 13

Tsuetaki v. Novicky, No. 80 CH 4724 (Cir. Ct. Cook Cty. Ill. Jan. 31, 1981) 3
Tsuetaki v. Novicky, No. 81-1727 (3d Div. 1983) 3, 14, 15

United States v. Lovasco, 431 U.S. 783, 97 S.Ct. 2044, 52 L.Ed. 2d 752 (1977) 16

Waterman v. Mackenzie, 138 U.S. 252, 11 S.Ct. 334, 34 L.Ed. 923 (1891) 11
White v. Arco/Polymers, Inc., 720 F.2d 1391 (5th Cir. 1983) 10

PAGE

Statutes:

28 U.S.C. §1254(1) 3
28 U.S.C. §1738 5

Other Authorities:

4 WALKER ON PATENTS §341, at 367, 370-74 (Deller's 2d ed. 1965) 12
9 WIGMORE, EVIDENCE §2590, at 822 (Chadbourn rev. 1981) 11

IN THE

Supreme Court of the United States

October Term, 1985

No. 85-1243

NICK N. NOVICKY,

Petitioner,

vs.

SYNTEX OPHTHALMICS, INC., and ARAPAHOE CHEMICALS, INC. (now SYNTEX CHEMICALS, INC.),

Respondents.

NICK N. NOVICKY,

Petitioner,

vs.

GEORGE F. TSUETAKI and FUSED KONTACTS OF CHICAGO, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF RESPONDENTS IN OPPOSITION

Respondents, Syntex Ophthalmics, Inc. and Arapahoe Chemicals, Inc. (now Syntex Chemicals, Inc.) (hereinafter collectively "Syntex") respectfully request that the Court deny Nick N. Novicky's (hereinafter "Novicky") Petition

for a Writ of Certiorari. Neither the questions presented nor the reasons given by petitioner for grant of the writ provide appropriate bases for the exercise of this Court's discretionary jurisdiction, because there was no error below and because petitioner's assertions are (a) barred by unappealed law of the case, (b) beyond the narrow scope of remand or (c) premature because asserted in a pending Appeal in the Federal Circuit.

OPINIONS BELOW

A. The Federal Case

The decision of the District Court for the Northern District of Illinois granting Syntex a preliminary injunction is reported as *Syntex Ophthalmics, Inc.* v. *Novicky*, 214 U.S.P.Q. 272 (N.D. Ill. 1982), *aff'd sub nom., Syntex Ophthalmics, Inc.* v. *Tsuetaki*, 701 F.2d 677 (7th Cir. 1983). The opinion of the District Court for the Northern District of Illinois holding Novicky misappropriated Syntex' trade secrets and granting a final injunction is reported as *Syntex Ophthalmics, Inc.* v. *Novicky*, 595 F. Supp. 28 (N.D. Ill. 1983), *aff'd in part, rev'd in part*, 745 F.2d 1423 (Fed. Cir. 1984). The opinion of the Court of Appeals for the Federal Circuit affirming the District Court's findings of trade secret theft and grant of summary judgment as to Syntex' title to six of the eight patent and applications in issue is reported at 745 F.2d 1423 (Fed. Cir. 1984). On remand on other issues, the District Court entered judgment for Syntex on September 4, 1985, now on appeal to the Federal Circuit. Novicky's first Petition for Certiorari was granted, and judgment vacated and remanded on

March 18, 1985, reported at *Novicky* v. *Syntex Ophthalmics, Inc.* —— U.S. ——, 105 S.Ct. 1740, 84 L.Ed.2d 807 (1985). The opinion of the Federal Circuit on remand, the subject of the present Petition, is reported at *Syntex Ophthalmics, Inc.* v. *Novicky*, 767 F.2d 901 (Fed. Cir. 1985).

B. The State Case

The decision of the Illinois state court is reported as *Tsuetaki* v. *Novicky*, No. 80 CH 4724 (Cir. Ct. Cook Cty. Ill. Jan. 31, 1981). The Illinois Appellate Court decision is reported as *Tsuetaki* v. *Novicky*, No. 81-1727 (3d Div. 1983).

JURISDICTIONAL STATEMENT

This Court only has jurisdiction to review the decision of the Court of Appeals for the Federal Circuit in this matter pursuant to 28 U.S.C. § 1254(1), if a writ of certiorari is granted upon Novicky's petition. The judgment of the Federal Circuit for which this Court's review is sought, was decided July 18, 1985.

SUMMARY OF ARGUMENT

This Court's decision of March 18, 1985, ordered the Federal Circuit to reconsider its prior decision in light of *Marrese* v. *American Academy of Orthopaedic Surgeons*, 470 U.S. ——, 105 S.Ct. 1327, 84 L.Ed. 2d 274 (1985), by applying Illinois law of collateral estoppel rather than federal law. The Federal Circuit did precisely that, and in a well-reasoned opinion reaffirmed its prior decision.

The District Court, meanwhile, proceeded under the original remand from the Federal Circuit which was not appealed to this Court and was therefore unaffected by this Court's decision. Further, no final judgment was entered by the District Court until the Federal Circuit mandate was issued, mooting any controversy about the power of the District Court to act.

Novicky's arguments about, *inter alia,* removal (Petitioner's Brief page 15, "PB p. 15"), the original denial of remand to the state court (PB p. 25) and entry of a preliminary injunction (PB p. 19), have been previously denied, are therefore the law of the case, and should not be considered further.

Other arguments, such as the District Court's denial of Novicky's demand for a jury trial, are premature, since these very same issues are now on appeal to the Federal Circuit.

In short, most of the Petition is but a thrice-warmed rehash, and on the one real issue of *Marrese,* 105 S.Ct. 1327, Petitioner is reduced to alleging falsely that "The Federal Circuit just ignored this Court's Order . . . " (PB p. 28). In fact, the Federal Circuit carefully considered *Marrese* and Illinois law, and its decision should stand.

COUNTER STATEMENT OF THE CASE

Once again, Novicky has devoted most of his brief to a narrative largely unsupported by the record. In the interest of brevity, Syntex commends the opinions below (citations *supra* pp. 2-3) for their concise statements of the

actual findings of fact. To date, five different courts have summarized the relevant facts: the Illinois state trial court, the Illinois Appellate Court, the District Court for the Northern District of Illinois (twice), the Court of Appeals for the Seventh Circuit, and the Court of Appeals for the Federal Circuit. The well-reasoned and thorough opinions of District Court Judge Decker and Federal Circuit Judge Davis state the relevant facts most accurately and succinctly, and do not need repetition here.

These decisions convey also the duration of this legal saga and the lengths to which our system of justice will go to afford an individual his days in court. However, at this stage, there being no error below, simple justice and common sense urge denial of the Petition.

ARGUMENT

The narrowest issue on remand presented by *Marrese*, 105 S.Ct. 1327, is "whether a state court judgment may have preclusive effect on a federal antitrust claim that could not have been raised in the state proceeding." *Id.* at 1331. Here, of course, the claims in the state and federal actions were of the same nature, namely misappropriation of trade secrets and ownership of patents, although only the title to the "non-private" patents and applications is relevant in the remand of these appeals.

Marrese also stands for the broader proposition that 28 U.S.C. § 1738 "requires a federal court to look first to state preclusion law in determining the preclusive effects of a state court judgment." *Marrese*, 105 S.Ct. at 1332.

Stated more precisely, the concern in *Marrese* is that a federal court might give a greater preclusive effect to a state court judgment than the state court itself might give. Again, this concern is not present here, since Syntex' claim to patent title is based on (a) state preclusion law that is essentially the same as the federal law relied upon by this Court (*see* discussion *infra*); or (b) valid assignments recorded in the PTO (*see* discussion *infra*).

Notwithstanding *Marrese's* note that state law determines the effect of a state court settlement and consent order, *Id.* at 1333, fn. 2, here the settlement between Tsuetaki and Syntex, upon which Syntex relied, was entered in the federal action. This negates any need to look to state law with respect to Tsuetaki's assignment to Syntex.

Thus, the narrow question presented is whether the Federal Circuit's decision on remand went beyond Illinois state law in deciding the title issue as to the non-private patents and applications. The answer is no.

A. Summary Judgment Of Syntex' Title To The Non-Private Patents And Applications Was Properly Reaffirmed

The Federal Circuit on remand reaffirmed its decision, since relevant Illinois law on issue preclusion is essentially the same as the federal law, *Spiller* v. *Continental Tube Co.*, 95 Ill. 2d 423, 447 N.E.2d 834 (1983). Specifically, assuming *arguendo* that the Illinois trial court's judgment is vacated and remanded for a new trial between Novicky and Tsuetaki, under Illinois law the lower court must retry the case in conformity with the opinion of the appellate

court. *Pittsburgh, Cincinnati, Chicago & St. Louis Railway Co.* v. *Gage*, 286 Ill. 213, 217, 121 N.E. 582, 584 (1918); *Shlensky* v. *South Parkway Building Corp.*, 44 Ill. App. 2d 135, 194 N.E.2d 35, 38 (1st Dist. 1963).

This does not mean that a bare mandate negates the actual opinion. Even the main case relied on by Novicky, *PSL Realty Co.* v. *Granite Inv. Co.*, 86 Ill. 2d 291, 427 N.E. 2d 563, 571 (1981) states "[i]n construing the language [of the mandate] matters which are implied may be considered embraced by the mandate. [Citations omitted.] The trial court may only do those things directed in the mandate. [Citation omitted.] The trial court has no authority to act beyond the dictates of the mandate."

Other Illinois cases have parallel language:

Bradley v. *Howard Hembrough Volkswagen, Inc.*, 89 Ill. App. 3d 121, 124, 411 N.E.2d 535, 537 (4th Dist. 1980):

> When a trial court's judgment is reversed, the trial court is clearly bound by the appellate court's determination of all questions decided and can only act in such proceedings in a manner as conforms to the appellate court's judgment.

Pittsburgh, Cincinnati, Chicago & St. Louis Railway Co. v. *Gage*, 286 Ill. 213, 217, 121 N.E. 582, 584 (1918):

> Where a judgment is reversed by an appellate court, the judgment of the appellate court is final upon all questions decided, and those questions are no longer open to consideration. If the cause has been remanded, the court to which it is remanded can take only such proceedings as conform to the judgment of the appellate court. If specific directions are given, the court

> can do nothing but carry out the specific directions. If specific directions are not given, it must be determined from the nature of the case what further proceedings are proper, and it is the duty of the court to which the cause is remanded to examine the opinion and proceed in conformity with it.

Shlensky v. *South Parkway Building Corp.*, 44 Ill. App. 2d 135, 194 N.E.2d 35, 38 (1st Dist. 1963):

> It was the duty of the Circuit Court to examine the opinion of the Supreme Court and proceed in conformity with it.

The Federal Circuit thus correctly read the Novicky Illinois Appellate Court decision as to the non-private patents and applications. Although the Illinois Appellate Court did not give specific instructions to the trial court, it did (as noted by the Federal Circuit at 745 F.2d at 1431-32) accept the trial court's findings that Tsuetaki was the owner of the four non-private patents (plus the two divisionals of the '303 patent) and applications which were assigned by Tsuetaki to Syntex pursuant to the settlement agreement. The Illinois Appellate Court also accepted the trial court's finding that Novicky conceded the other patents and patent applications at issue were assigned to Tsuetaki in accordance with the original employment agreement signed by Novicky.

Also, the Illinois Appellate Court noted that (1) Novicky was paid a total of $20,000 for patent application Serial No. 6725 (U.S. Patent No. 4,216,303), (2) Novicky filed two more applications for other inventions which "Novicky agrees belong to Tsuetaki" and (3) Novicky filed

three additional patent applications, only two of which [the '483 and '989 private patents] Novicky claimed belong to him.

In any retrial in the Illinois state court, the only issue thus remaining is modification of the original Novicky/Tsuetaki employment agreement as it relates to Tsuetaki's payments to Novicky for production of contact lens polymeric rods. These contact modification issues are neither part of Novicky's Petition for Writ nor did Syntex assert such modifications as collateral estoppel. Further, the original employment agreement entered into between Novicky and Tsuetaki dealing with assignment of the non-private patents would not be at issue. The Illinoise trial court, in conformity with the Illinois Appellate Court's decision, would thus collaterally estop Novicky from retrying any issues as to the validity of his assignments of the non-private patents to Tsuetaki under the original agreements, the same result reached by the Federal Circuit.

Therefore, the preclusive effect of the Illinois Appellate Court's judgment is the same under both state and federal law, and the *Marrese* decision has no effect on the result of the Federal Circuit's prior decision.

B. The Recorded Assignments Perfect Syntex' Title To The Patents In Issue

In deciding whether to reaffirm summary judgment of title to the non-private patents and applications in Syntex, an appellate court can look to the entire record, *Bushman Construction Co.* v. *Conner*, 307 F.2d 888, 892-93 (10th Cir. 1962) and can apply the same tests as a district court, *Goodman* v. *Mead Johnson & Co.*, 534 F.2d 566, 573 (3rd Cir. 1976), *cert. denied*, 429 U.S. 1038 (1977). The Federal

Circuit (or this Court) thus could have relied on Tsuetaki's settlement with Syntex of the federal action, the recorded assignments in the Patent Office and the admissions of the parties, without addressing Illinois law on issue preclusion.

Marrese thus does not affect the federal issue of the effectiveness of Tsuetaki's assignments of the non-private patents and applications to Syntex. The existing appeal record as to these patents and applications show that:

1. Novicky assigned U.S. Patent No. 4,216,303 to Tsuetaki. This assignment is recorded in the Patent and Trademark Office and is shown on the face of the '303 patent.

2. Novicky also assigned U.S. Patent Nos. 4,314,068 and 4,365,074 to Tsuetaki. These are divisionals of the '303 patent, and are covered by the original assignment.

3. Novicky also executed written recorded assignments for three other applications, namely applications Serial Nos. 072,449 (issued as U.S. Patent No. 4,303,772); 103,408 (abandoned) and 081,682 (abandoned).

4. Further, while represented by counsel, Novicky filed a sworn Answer to Tsuetaki's state court complaint admitting that the three applications listed in paragraph three above were assigned to Tsuetaki, pursuant to the terms of the Agreement. Such pleadings, at a minimum, act as adverse evidentiary admissions against Novicky, *White* v. *Arco/Polymers, Inc.*, 720 F.2d 1391, 1396 (5th Cir. 1983), whether or not they are considered conclusively binding, *Myers* v. *Manchester Insurance & Indemnity Co.*, 572 F.2d 134 (5th Cir. 1978); *Mull* v. *Ford Motor Co.*, 368

F.2d 713, 715-16 (2d Cir. 1966); *Scaife* v. *Western North Carolina Land Co.*, 90 F. 238, 240-41 (4th Cir. 1898), *cert. denied*, 173 U.S. 705 (1899); 9 WIGMORE, EVIDENCE § 2590, at 822 (Chadbourn rev. 1981).

5. The '772 patent referred to in paragraph three above also shows assignment to Tsuetaki on its face.

Thus all of the non-private patents and applications here in issue have valid, recorded assignments from Novicky to Tsuetaki. As part of the settlement with Syntex, Tsuetaki executed an assignment of all of these patents and applications to Syntex, also recorded in the Patent and Trademark Office. Accordingly, the state and federal court and Patent and Trademark Office records show that Novicky's assignments to Tsuetaki were valid and effective. Novicky never challenged the fact of these assignments of the non-private patents and applications in either the state or federal actions.

At the time Novicky assigned the patents and applications to Tsuetaki for valuable consideration, there was no dispute as to the validity of the assignments nor were there any prior recorded or unrecorded assignments more than three months old. Therefore, Tsuetaki's title in the non-private patents and applications became absolute and Syntex' acquisition of those patents and applications with knowledge of the prior assignments gave it the entire right, title and interest to those patents and applications which cannot be cut off now by Novicky. *Crown Die & Tool Co.* v. *Nye Tool & Machine Works*, 261 U.S. 24, 36-37, 43 S.Ct. 254, 67 L.Ed. 516 (1923); *Waterman* v. *Mackenzie*, 138 U.S. 252, 255, 11 S.Ct. 334, 34 L.Ed. 923 (1891); *Gayler* v.

Wilder, 51 U.S. 477, 480-81, 492-94, 13 L.Ed. 504, 505-06, 510-11 (1850); *Heywood-Wakefield Co.* v. *Small,* 96 F.2d 496, 499-500 (1st Cir. 1938), *cert. denied,* 305 U.S. 663 (1938); 4 WALKER ON PATENTS § 341, at 367, 370-74 (Deller's 2d ed. 1965).

At the time Syntex recorded its assignment from Tsuetaki of the non-private patents and applications, the records of the Patent and Trademark Office revealed title to such patents and applications in Tsuetaki. Syntex' assignments from Tsuetaki thus give it title to the non-private patents and applications without reference to state preclusion law, since Syntex relied upon the federally recorded conveyances from Novicky to Tsuetaki.

C. Denial Of Mandamus Was Proper Because The District Court Was Acting Under A Mandate

Novicky focuses only on the last month of the complex remand sequence to allege that the District Court had no power to issue its September 4, 1985 decision. This ignores the simple fact that the District Court acted under a valid mandate entered a year earlier which was unaffected by this Court's decision.

The Federal Circuit issued its original remand mandate on October 3, 1984. Judge Decker then scheduled a status conference and hearing for February, 1985. In January, Novicky filed his first Petition for Certiorari. He then filed a motion to *recall* the mandate which was then admittedly already issued. The Federal Circuit denied the motion to recall on January 28, 1985.

The trial court then proceeded with an evidentiary hearing on February 7, 1985. On March 18, 1985, this Court

entered its decision remanding for consideration of *Marrese*. The Federal Circuit on July 18, 1985 reaffirmed its earlier decision, expressly holding that its original remand to the District Court had "nothing to do with the Supreme Court's *Marrese* decision and opinion, and are in no way affected by either." (Appellant's Appendix A-48 and 767 F.2d at 902)

Thus the District Court's hearing on February 5, 1985 was effective under the original mandate, as was its decision on September 4, 1985 after the Federal Circuit's reaffirmation on July 18, 1985.

Finally, the issue is moot since the Federal Circuit issued the mandate on its reaffirmation on remand from this Court on October 2, 1985 (delayed by Novicky's motion for rehearing). Certainly, then, its denial of the mandamus alleging no mandate on October 20, 1985 was well founded and proper.

D. Novicky's Remaining Arguments Are Barred By Law Of The Case, Are Beyond The Narrow Remand, Or Are Premature

Novicky's brief blithely ignores the repeated, binding findings of fact of the courts below. For example, Novicky asserts the batch sheets he stole and sold to Tsuetaki had no value (PB pp. 6-8), ignoring repeated holdings that Syntex had valuable trade secrets in them. *Syntex Ophthalmics, Inc.* v. *Novicky*, 745 F.2d 1423, 1434 (Fed. Cir. 1984); *Syntex Ophthalmics, Inc.* v. *Tsuetaki*, 701 F.2d 677, 683 (7th Cir. 1983). Novicky also asserts he independently conceived a monomer called S-9, ignoring the findings that this was not independent of his work for Syntex. *Syntex Ophthalmics, Inc.* v. *Novicky*, 591 F. Supp. 28, 34 (N.D. Ill. 1983); *Tsuetaki*, 701 F.2d at 682.

Novicky's assertion of improper removal (PB pp. 15-16) likewise ignores clear holdings that removal was proper. *Novicky*, 745 F.2d at 1431.

Novicky's claim of total victory in the Illinois Appellate Court (PB p. 17) also ignores that court's holding that the private patents belonged to Syntex [*Tsuetaki* v. *Novicky*, No. 81-1727 (3d Div. 1983)] and Novicky's binding admissions that he assigned the other patents to Tsuetaki. *Novicky*, 745 F.2d at 1432.

Novicky's complaint that there was no evidentiary hearing on the preliminary injunction (PB p. 19) ignores the affirmance on appeal based on the clear holdings that he copied Syntex' trade secrets "almost verbatim". *Novicky*, 591 F. Supp. at 35; *Novicky*, 745 F.2d at 1435. Novicky's challenges to the final injunctions (PB pp. 23-24, 31) are pending in the Federal Circuit, precluding consideration here.

Novicky's assertion that he began work on the private patents after leaving Syntex (PB pp. 19-20) ignores his binding admissions of fact to the contrary. *Novicky*, 591 F. Supp. at 37; *Novicky*, 745 F.2d at 1433 n.20.

Novicky's use of innuendo, by referring to a "mysterious settlement agreement" (PB p. 22), ignores the simple fact that the legally operative patent assignments on which summary judgment was based were filed in open court. *Novicky*, 591 F. Supp. at 30.

Novicky also claims he should have title to all the patents because of his theory of rescission of an August 1978 contract, ignoring repeated findings that the August con-

tract only affected the two private patents, not his separate legal assignment of the '303 and other non-private patents to Tsuetaki. *Tsuetaki* v. *Novicky,* No. 81-1727 (3d Div. 1983); *Novicky*, 745 F.2d at 1431-32.

Title to the two private patents, which Novicky repeatedly admitted he invented while at Syntex (745 F.2d at 1433) are of course not in issue here. The Federal Circuit remanded this issue to the District Court for a hearing. That hearing resulted in a finding that Syntex directly owned the private patents because Novicky invented them while under an employment contract with Syntex, not relying on collateral estoppel from the Illinois state court decision. Therefore, *Marrese* has no effect on the private patents.

Novicky's claim that he has been denied a hearing on his counterclaim to title to the private patents (PB p. 26) is simply false. Such a hearing was held on February 7, 1985, the same day that Novicky's counsel for this petition withdrew because Novicky filed a *pro se* civil rights lawsuit against the Honorable Judge Decker. Novicky himself served the complaint the day of the hearing, but said in an affidavit filed in the pending Federal Circuit appeal that he did not attend because he saw a U.S. Marshal outside the courtroom and was afraid to re-enter the same room where he had earlier served his complaint.

In any event, Novicky has a pending appeal in the Federal Circuit involving, *inter alia,* title to these private patents. Therefore, any assertion here about such proceedings, including any claim to a jury trial, is premature.

Finally, Novicky did not challenge any of the court's decisions below on due process grounds. Novicky's asser-

tion that he has been deprived of property without due process of law was neither pleaded, argued, nor briefed either in the District Court or in the Federal Circuit, and therefore, this Court should not consider it here. *See e.g., Dunigan* v. *United States,* 274 U.S. 195, 200 (1927); *Ellis* v. *Dixon,* 349 U.S. 458, 460 (1955); *United States* v. *Lovasco,* 431 U.S. 783, 789 n.7 (1977).

In short, to use Novicky's words, it is *his* case which is "in shambles" (PB p. 32). The accumulated court decisions have hemmed him in so narrowly that he now simply ignores them to fabricate a story grounded in fantasy.

CONCLUSION

This Court's narrow concern in remanding to the Federal Circuit, namely consideration of *Marrese,* has been fully and properly addressed by the Federal Circuit. Novicky's Petition For Writ of Certiorari should be denied because it raises no effective challenge to that decision and dwells instead on issues either long decided or premature.

Novicky's Petition For Writ of Certiorari should accordingly be DENIED.

Respectfully submitted,

JAMES W. GOULD
(Counsel of Record)

JOSEPH A. DEGIROLAMO
Attorneys for Respondents Syntex Ophthalmics, Inc. and Arapahoe Chemicals, Inc. (now Syntex Chemicals, Inc.)